

REMARKS

Claims 24-47 are currently pending. Claims 43-45 have been withdrawn from consideration. Claims 24 and 32 have been amended to further define the invention. Support for the claim amendment may be found on page 6, lines 17-30. No new matter has been added.

1. Rejections under 35 U.S.C. §103(a)

The Examiner has rejected claims 24-42 and 46-47 for the reasons set forth in the Office Action of May 13, 2003. The Examiner had rejected the claims as being obvious in view of Gill et al. (US Patent No. 4,892,590). Gill is directed to a paper making process comprising chemical pulp (i.e. uncoated wood-free paper) whereas the present invention is directed to regulating the porosity and printing processes of uncoated wood-containing papers. Applicant had previously argued that a person of ordinary skill in the art would not be motivated to modify Gill in the manner suggested by the Examiner because (1) the skilled artisan would know that there are significant technical differences between utilizing wood-containing papers versus chemical pulp (wood-free pulp or paper) in the paper manufacturing process; (2) the skilled artisan would have no basis to expect that colloidal PCC would work as a porosity controlling agent in a technically different paper-type (i.e. wood-containing paper) and (3) that the skilled artisan, based on the teachings of Gill, would not have a reasonable expectation of success if he attempted to utilize colloidal PCC to regulate the porosity of uncoated wood-containing paper. The Examiner states that these arguments have been fully considered but were not found persuasive.

The Examiner specifically states that the claims do not sufficiently define the paper or pulp used in the instant process because the distinction between wood-free and wood-containing papers is unclear (See page 2 of the Office Action: "there seems to be overlapping ranges in the amount of

lignin containing pulp in the paper, i.e., page 6 of the specification, lines 17-30 . . .). The Examiner argues that based on this passage, a paper could be defined as both a wood-free and a wood-containing paper. Applicant has amended the claims to overcome this problem. In the amended claims, the wood-containing paper or pulp used in the process must have at least 10% by weight of the pulp be lignin-containing pulp. Thus, the distinction between wood-free and wood-containing paper is now clear. Wood-free paper is defined as paper in which less than 10% by weight of the pulp is groundwood or other lignin-containing pulp. And, wood-containing paper is defined as paper in which at least 10% by weight of the pulp is groundwood or other lignin-containing pulp. The claims as amended now clearly define the pulp or paper used in the process and clearly distinguish the present invention over the prior art reference.

Applicant offers the following comments in response to the Examiner's statement regarding claims 32-42. The Examiner has stated that even if the differences between wood-free and wood-containing papers were resolved, the Gill reference would still read on claims 32-42 because these claims do not require the paper to be wood-containing. Applicant strongly disagrees. Dependent claims 33-36 depend from claim 32 which defines the paper as an "uncoated wood-containing paper". The Examiner's statement with respect to claims 32-36 is clearly in error as these claims are directed to wood-containing paper. With respect to claims 37-42, these claims relate to specific types of paper characterized by the content of PCC. Thus, these claims do not need to be limited to only wood-containing paper. Accordingly, Applicant submits that claims 37-42 are also patentably distinguishable over the cited prior art reference.

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In view of the foregoing remarks, Applicant submits that the claims as amended have clearly defined the pulp or paper used in the process in order to indicate allowability of the claims. As such, Applicant respectfully requests reconsideration and removal of the rejection.

Favorable consideration and early allowance of all of the claims is solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Leonard R. Svensson (Reg. No. 30,330) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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Susan M. Langworthy  
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\_\_\_\_\_  
Signature  
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By Kalpana Rolly #46, 183  
\_\_\_\_\_  
Leonard R. Svensson, #30,330

P.O. Box 747  
Falls Church, VA 22040-0747  
(714) 708-8555

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